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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,245	03/06/2000	Chaitanya Kanojia	2657.2001003	8263

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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,245

Applicant(s)

KANOJIA ET AL.

Examiner

Jeffrey D. Carlson

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-- Th MAILING DATE of this communication appears on th cover she t with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)



- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the paper(s) filed 1/28/2003.

Claim Rejections - 35 USC § 112

2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

  Claim 12 depends from canceled claim 11, rendering the claim scope unclear. Correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (US6446261) in view of Khoo et al (US6434747) and Marsh et al (US5848397). Rosser teaches methods of inserted downloaded advertisement material into a user's TV programming. The user's set top box monitors the users viewing behavior in order to develop a user profile. Ads are associated with required viewer profiles (group profiles) so as to target the ads to the appropriate users. Rosser stores the profiles locally. Khoo et al also teaches delivery of content over a data network and subsequent insertion

of targeted ads to a TV viewer, based on the user profile. Khoo et al teaches the storage of the ad content and profile in a remote server which is provided with media transport service module acting as a bulk transfer manager and agent to access and download the content to the various users [col 6 lines 55-58]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the profiles in a remote server as taught by Khoo et al. Khoo et al teaches that the client devices are instructed to only download content which matches the user profile and customizes media list; the entire collection of available content is not sent to the user, but only a portion based on the profile/customized media list. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded only the customized content for each user, based on their profile, so that processing and resources are not burdened with downloading content that does not match the profile and will never be shown. Rosser and Khoo et al do not teach scheduling the downloading of ad collections. Marsh et al however also teaches systems for customized ads displayed to a user. Marsh et al teaches an advertisement download scheduler which determines when the ads are sent to each targeted user [3:27-30, 16:29-31, 16:51-53]. It would have been obvious to one of ordinary skill at the time of the invention to have provided/delivered scheduling data (messages) to each user device so that downloading of ads to the user devices was scheduled for optimization. Regarding the device addressing information, each profile that identifies a user is also taken to identify a device which has a device address in order to receive updated advertising. The scheduling of ad downloading is specific to a user/device. The system of Rosser provides signaling to the set top box to insert the

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appropriate ad (system manager functionality). Rosser teaches activation criteria of turning on the TV, for example [col 4 lines 60-64].

Regarding claims 8 and 9, Rosser also teaches switching channels as an event for ad activation/display.

Response to Arguments

5. Applicant's arguments with respect to amended claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc